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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/357,103	07/19/1999	CEES A. VAN DER VOORT	082671/0105	8718

7590

04/20/2004

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EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

App.

# Office Action Summary

Application No.

09/357,103

Applicant(s)

VAN DER VOORT, CEES A.

Examiner

Anne Marie Grunberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The petition to revive the application has been granted (paper number 17, dated 1/23/04). As a result, an RCE has been established. An action on the RCE follows.

The amendments to the specification have been entered and the specification is deemed to be as complete as is reasonably possible.

***Claim Rejections and Response to Arguments***

1. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by each of Plant Breeder's Rights NL PBR LEL1147, BE PBR 25125, CL PBR 00037, FR PBR 0158497, NZ PBR LIL025, PL PBR LIO0050, DE PBR LIU 00079, and the Aalsmeer website in light of Applicant's admission that the instant plant was for sale as of October, 1997 in the Netherlands.

Claim 1 is drawn to a lily 'Bernini'.

The lily plant 'Bernini' is described in each of the above referenced publications. The fact that 'Bernini' was on sale and thus in the public domain more than one year prior to the U.S. filing date in combination with the described publications elicits a 102(b). See below for more information.

The claimed lily variety 'Bernini' is described in Breeder's Right NL PBR LEL1147 granted in The Netherlands on 16 May 1995, on an application filed on 5 November 1993. The

additional Breeder's Right numbers include BE PBR 25125 filed 22 September 1995; CL PBR 00037 filed 13 November 1995; FR PBR 0158497 filed 4 September 1995; NZ PBR LIL025 filed 15 May 1995; PL PBR LIO0050 filed 4 December 1995; and DE PBR LIU 00079 filed 6 September 1995.

The published grant, application and published proposed denomination are each "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number and grant number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the grant are obtainable through the Netherlands Board of Plant Breeders' Rights. Notice of Plant Breeder's Right grants is also published in the *Nederlandse Staatscourant*. Plant varieties are also entered in the Netherlands Register of Varieties, which is public. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to

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a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.").

Applicant argues that the publications are not enabled because they do not provide a method of making 'Bernini'. This argument has been carefully considered, however is not persuasive because as described above, one of ordinary skill in the art would have been able to buy the plant, ie the public had possession of the plant described in the above referenced printed publications. Additionally, based on knowledge of one of ordinary skill in the art, one would have been able to asexually reproduce the instant plant thus obtained. However, the mere fact that the public had possession of the plants enables the publications.

The claim is not allowed.

#### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grünberg whose telephone number is (571) 272-0975. The examiner can normally be reached from Monday through Thursday from 7:30 until 5:00, and every other Friday from 7:30 until 4:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached at (571) 272-0974. The fax number for the unit is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

**ANNE MARIE GRUNBERG  
PRIMARY EXAMINER**